THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte TAKAHIRO MIYAZAKI

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Appeal No. 96-3258
Application 08/241,875[1]

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ON BRIEF

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Before THOMAS, KRASS and TORCZON, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed May 12, 1994.

Appellant has appealed to the Board from the examiner's final rejection of claims 4 to 10 and 13, which constitute all the claims remaining in the application.

Representative claim 4 is reproduced below:

4. A low power, high speed driving circuit comprising:

a power terminal for connection to a power voltage source;

a current source for providing current outputs including a first current and a second current proportional to the first current, the second current being input into the first current;

a control circuit operably connected to said current source and generating a control signal applied to said current source;

said current source being initiated in response to the control signal from said control circuit and being controlled by said control circuit such that the sum of the first current and the second current input into the first current is a constant magnitude;

a switching element having input, output and control terminals, the input terminal of said switching element being connected to said power terminal, and the output terminal of said switching element having a predetermined output potential threshold; and

said switching element becoming conductive in response to the input of the second current from said current source to the control terminal thereof in dependence upon the potential of said output terminal being lower than the predetermined output potential threshold thereof.

There are no references relied on by the examiner.

Claims 4 to 10 and 13 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. The examiner's position is expressed at pages 3 and 4 of the Answer.

Rather than repeat the positions of the appellant and the examiner, reference is made to the Brief[2] and the Answer for the respective details thereof.

OPINION

For all the reasons expressed by the examiner in the Answer, and for the additional reasons presented here, we will sustain the rejection of claims 4 to 10 and 13 under the second paragraph 35 U.S.C. § 112.

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[2] The Reply Brief filed on September 4, 1996 has not been entered by the examiner in a communication dated September 25, 1996. Therefore, we have not considered it in our deliberations.

Under the second paragraph of 35 U.S.C. § 112, it is to be noted that to comply with the requirements of the cited paragraph, a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure and the teachings of the prior art as it would be by the artisan. Note In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

Our own study of representative claim 4 in a vacuum leads us to the same questions raised by the examiner at pages 3 and 4 of the Answer.

When we study the subject matter of representative claim 4 on appeal in light of the disclosed invention, as we must in accordance with the above noted precedent, those problems and questions raised by the examiner at pages 3 and 4 of the Answer are in fact amplified rather than eliminated.

Additionally, the claimed first and second currents would appear only to correspond to currents I_1 and I_2 of representative Figure 1, for example. This study of the claimed invention in light of the disclosure reveals a very glaring discontinuity. The claimed switching element, comprising the last two clauses of representative claim 4 on appeal, is disclosed to be the NMOS transistor NT in representative Figure 1 and the other figures as well, even the conventional circuit shown in Figure 8. Note the discussion of this latter figure at the middle of page 1 of the specification indicates that "NT represents an NMOS transistor used as a switching element." A similar correspondence has been established at the bottom of page 6 of the specification, the top of page 7 and the entire short paragraph at the bottom of page 14. The language of representative claim 4 relating to the claimed switching element does not clearly correspond to the switching element of the disclosed invention.

All of these above problems are further compounded when appellant's arguments are considered in the Brief on appeal in at least two respects. At the beginning of the long paragraph

at page 8 of the Brief on appeal, the claimed switching element has been stated to correspond to the transistor Q_3, whereas the lower portion of this same paragraph at the bottom at page 8 indicates that this transistor is characterized as an output transistor, which feature and characterization is more consistent with the disclosed invention. Again, at the middle and bottom at page 9 of the Brief on appeal, the claimed switching element recited in representative claim 4 on appeal is again said to correspond to transistor Q_3. Also at the bottom of page 9 of the Brief, the claimed first current is said to correspond to I_1 and the claimed second current is said to correspond to the feedback current IFB, which is further characterized as being a modified version of I_2. In addition to separately characterizing IFB as a separate subcurrent from I_1 and I_2 in the disclosed invention, this characterization of appellant adds further ambiguity to what would appear to have been a normally clear correspondence of the claimed first and second currents with the latter two respective currents in representative Figure 1. In any event, this concern along with the discontinuity between the argued meaning of the claimed switching element and the disclosed

meaning of the same phrase further amplify the ambiguities of the presently claimed invention. As a whole, appellant's arguments in the Brief confirm the examiner's questions and ambiguities raised in the Answer as well as add to them.

Inasmuch as there are no arguments presented as to dependent claims 5 to 10, and in view of the fact that the subject matter of independent claim 13 on appeal mirrors the above language of independent claim 4 and further adds to it, the rejection of these claims is also sustained. Therefore, the decision of the examiner rejecting claims 4 to 10 and 13 under 35 U.S.C. § 112, second paragraph, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS Administrative Patent Judge	)
ERROL A. KRASS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	)

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